

Claim Status

Claims 1-7, 9-15, and 17-34 are pending in the application. Claims 1, 11, 19 and 21 are the independent claims. Claims 1, 7, 9-11, 18, and 33-34 are currently amended. Claims 8 and 16 are currently cancelled.

Section 103 Rejections

The Office Action rejected claims 1-2, 4-12, and 14-22 and 33-34 under §103(a) as being unpatentable over U.S. Patent Application Publication 2003/0033517 A1 to Rutherglen et al. ("Rutherglen"), in view of Applicant's admitted prior art ("AAPA"). The Office Action rejected claims 3 and 13 under §103(a) over Rutherglen and AAPA, further in view of "Java Applet Signing Guide" ("Wilson").

Applicant respectfully traverses the Examiner's findings on the scope of Applicant's admitted prior art ("AAPA"). The case of *Ex parte McGaughey*, 6 USPQ2d 1334, 1337 (Bd. Pat. App. & Inter. 1988, which is now embodied in MPEP 2258 Scope of *Ex Parte* Reexamination, contains an instructive discussion of the doctrine of AAPA:

An admission is defined as an acknowledged, declared, conceded or recognized fact or truth. [FN14] Thus, admissions are simply facts. In this case the admission is an uncontroverted fact. Moreover, as pointed out in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), "the scope and content of the prior art are to be determined" as a preliminary factual finding prior to deciding a question of patentability under 35 USC § 103. We hold that an admission relating to prior art is a fact which is part of the scope and content of the prior art which every examiner is required to consider whether in an initial examination or in a reexamination proceeding.

As we read section 305 of the statute, any unequivocal admission which would be considered in initial examination under sections 132 and 133 should be considered in a reexamination proceeding.

The above passages from *Ex parte McGaughey* contain several points that bear on the present rejection:

Firstly, admissions are facts, which can be uncontroverted or disputed – in this case the facts are disputed. A rejection based upon AAPA included in the Office action of May 20, 2008 and the alleged facts underlying this AAPA were rebutted by Applicant in the Response to this Office action. In repeating this rejection in the present Office action it was incumbent on the Examiner to respond to the factual presentation in the *Response to Arguments*, which was not done. Applicant will repeat and elaborate upon these rebuttal facts and arguments herein.

Secondly, the legal effect of an alleged Applicant's admitted prior art is serious, and should be based on a clear admission -- *Ex parte McGaughey* refers to "any unequivocal admission". Here, Applicant's alleged admissions are anything but clear. The current Office action quotes page 6, lines 14-21 of the specification, and states that Applicant "admitted" this passage. However, nowhere in this passage is there any statement or implication that the described subject matter is prior art. The term "prior art" is not used, nor is any other term of this type (such as "background art" or "related art") used. The examiner has not shown, and cannot show, that Applicant has admitted that this described subject matter is prior art.

Likewise the quoted passage from page 9, lines 16-17 the specification does not contain any admission adequate for AAPA that "the file transfer technique according to one embodiment of the invention" is prior art. This passage states that "FIG. 9 shows details of a server initiated

download, known as a ‘push’ operation” and then continues to describe how the push operation utilizes a file transfer technique according to one embodiment of the invention. The passage does not state or imply that the file transfer operation according to one embodiment of the invention is known as a “push operation”. The Office action provides no facts to support any broader scope of AAPA based upon this passage.

Thirdly, *Ex parte McGaughey* points out the relationship between AAPA and the *prima facie* case of obviousness under Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966).

Even if it is conceded that Applicant admitted in the specification that a server initiated download, known as a “push” operation is prior art, the Office is still required to determine the scope and content of this prior art. Applicant respectfully submits that the scope of this admission is simply that a server-initiated download, known as a “push” operation, is prior art. Absent any factual showing that the following claim features are inherent in server initiated downloads known as “push” operations, the Office action has failed to meet its burden that these features are within the scope and content of the prior art:

- the file is pushed from the server through the firewall by a target registering with the server behind the firewall,
- polling the server for files to be downloaded, and
- downloading the file from the server through the firewall over a virtual channel
- and by the server receiving a registration at the server behind the firewall,
- receiving polling of the server for files to be downloaded, and
- downloading the file from the server through the firewall over a virtual channel,
- wherein the downloading the file from the server through the firewall permits transferring a large file in chunks.

[Note that applicant has amended the above claim features to provide a positive recitation of transferring a large file, as discussed below].

Furthermore, a *prima facie* case of obviousness requires ascertaining the differences between the prior art and the claims at issue. The Office action states that it would have been obvious to achieve the claimed invention since a “push” operation was known in the prior art as demonstrated in the “Gnutella Protocol Specification”, particularly regarding “pushing” a file. However, this statement does not discuss the specific teachings of the “Gnutella Protocol Specification”, nor does it relate this reference’s teachings to the claim limitations at issue.

In summary, Applicant respectfully submits that the Office action has failed to satisfy the requirements of a *prima facie* case of obviousness of demonstrating that it would be obvious to achieve the claimed invention due to AAPA. The Office action fails to provide an adequate showing as to the facts related to Applicant’s admission; the scope of and content of the prior art arising from Applicant’s admission (or arising from any other evidence of a “push” operation); and the differences between the prior art and the claims at issue.

Applicant respectfully traverses the rejection of independent claim 1 under 35 U.S.C. §103(a) as being unpatentable over Rutherglen in view of AAPA. Rutherglen does not disclose the recited features of claim 1, at least with respect to the claim feature:

wherein the large file is pushed from the server through the firewall to the file transfer gateway by a target registering with the server behind the firewall, polling the server for files to be downloaded, and downloading the large file from the server through the firewall over a virtual channel and by the server receiving a registration at the server behind the firewall, receiving polling of the server for files to be downloaded, and downloading the large file from the server through the firewall over a virtual channel; and wherein the large file is downloaded from the server through the firewall in chunks.

This claim feature is currently amended to refer to a “large” file, i.e. exceeding a pre-selected file size limit for transmission past the firewall. Furthermore the claim is amended to provide the positive recitation “wherein the large file is downloaded from the server through the firewall in chunks”. Applicant submits that this amendment requires the quoted step to be performed and thereby eliminates the intended use limitation discussed in MPEP 2111.04. As such, this claim recitation is properly relied upon to further distinguish claim 1 from the cited art.

The Examiner acknowledges that Rutherford does not expressly disclose the claim features quoted above, but relies on Applicant’s alleged admitted prior art to fill this gap. For reasons given above, Applicant traverses the conclusion that this subject matter represents AAPA. Furthermore, the current amendments to the claims – a large file of a size exceeding a pre-selected file size limit for transmission past the firewall, and a positive recitation that the large file is downloaded from the server through the firewall in chunks – provide additional distinctions over the prior art.

Applicant’s method authorizes a file requestor or target to receive a large file, e.g. in the context of B2B operations. The target is registered with a server behind a firewall, which enables the server to verify authenticity of the file transfer operation and to coordinate with the file transfer gateway in setting up file transfer parameters to be used in a later download operation. The target polls the server for files to be downloaded, e.g. because the files may normally be stored at a different location such as a collaboration manager of a B2B operation. Once a desired file is identified at the server, the file is downloaded from the server over a virtual channel through the firewall. The large file is downloaded in chunks.

Considering this combination of steps and features, this method is neither taught nor suggested by Rutherford's distributed-computing data accessing system, and indeed is incompatible with Rutherford's data accessing system. Rutherford's system initiates data requests from a client computer, which issues proxy objects to an application server to generate database requests. Data retrieved from the database is returned to the client computer via the application server using the proxy objects. This distributed computing method is quite different than a server-initiated push operation, and there is no proper basis to derive Applicant's claimed invention. This is reinforced by the current amendments to the claims providing for the transmission of a large file (exceeding a pre-selected file size limit for transmission past the firewall) in chunks through a firewall. Rutherford's objective is quite different – permitting the retrieval of a database file requested by a client computer without interruption by a security mechanism protecting the client computer.

Applicant respectfully traverses the rejection of independent claim 11 under 35 U.S.C. §103(a) as being unpatentable over Rutherglen in view of AAPA. Rutherglen does not disclose the recited features of claim 11, at least with respect to the claim features:

wherein the large file is pushed from the server through the firewall to the file transfer gateway by a target registering with the server behind the firewall, polling the server for files to be downloaded, and downloading the large file from the server through the firewall over a virtual channel and by the server receiving a registration at the server behind the firewall, receiving polling of the server for files to be downloaded, and downloading the large file from the server through the firewall over a virtual channel; and wherein the large file is downloaded from the server through the firewall in chunks.

Claim 11 is herein amended similarly to claim 1. The above arguments for the patentability of claim 1 over Rutherglen in view of AAPA apply to claim 11 as well.

Applicant respectfully traverses the rejection of independent claim 19 under 35 U.S.C. §103(a) as being unpatentable over Rutherglen in view of AAPA. Rutherglen does not disclose the recited features of claim 19, at least with respect to the following claim features:

wherein the file is transferred in chunks using a basic hypertext transport mechanism;  
and

wherein the file is pushed from the server through the firewall by a target registering with the server behind the firewall, polling the server for files to be downloaded, and downloading the file from the server through the firewall over a virtual channel and by the server receiving a registration at the server behind the firewall, receiving polling of the server for files to be downloaded, and downloading the file from the server through the firewall over a virtual channel.

The above arguments for the patentability of claim 1 over Rutherglen in view of AAPA apply to claim 19 as well. In addition, claim 19 includes the positive recitation that the file is transferred in chunks using a basic hypertext transport method, which further qualifies the step of transferring the file in chunks through a firewall.

Applicant respectfully traverses the rejection of independent claim 21 under 35 U.S.C. §103(a) as being unpatentable over Rutherglen in view of AAPA. Rutherglen does not disclose the recited features of claim 21, at least with respect to the following claim features:

wherein the file is transferred in chunks using a basic hypertext transport mechanism;

wherein the file is pushed from the server through the firewall by a target registering with the server behind the firewall, polling the server for files to be downloaded, and downloading the file from the server through the firewall over a virtual channel and by the server receiving a registration at the server behind the firewall, receiving polling of the server for files to be downloaded, and downloading the file from the server through the firewall over a virtual channel.

The above arguments for the patentability of claim 1 over Rutherglen in view of AAPA apply to claim 21 as well. In addition, claim 21 includes the positive recitation that the file is transferred

in chunks using a basic hypertext transport method, which further limits the step of transferring the file in chunks through a firewall.

Turning to the dependent claims, claim 2 recites that the web site is at a collaboration manager separate from the server. New claim 23 depends from claim 2 and recites the step of checking the file out from the collaboration manager to the server. Claims 2 and 23 describe two aspects of a B2B implementation of Applicant's method. A collaboration manager of a B2B operation can store sensitive files of the B2B operation, and can manage the authorization of B2B parties to access such files. These same considerations apply to corresponding dependent claims 14 and 24.

Dependent claim 9 recites that the chunks are transferred using a basic hypertext transport mechanism. Corresponding claim 17 depends from claim 11. These claims describe a preferred mechanism for transferring large files in chunks through a firewall. The Examiner cites paragraphs [0036] and [0037] of Rutherford as disclosing wherein the file is transferred in chunks. Applicant respectfully submits that these paragraphs do not disclose the transfer of a file from a server in chunks; rather they describe distributed computer applications that can require connecting to different or multiple servers.

Claim 25 depending from claim 1 recites the step of negotiating context information for transferring the file, wherein the server accepts or alters recommended context information sent by the file transfer gateway to the server. Claim 26 recites that the recommended context information comprises quality of service information and recommended file transfer parameters. Though this negotiation of file context information, the server and the file transfer gateway can coordinate in



establishing file transfer parameters for more efficient downloads of large files. The same observation applies to corresponding dependent claims 27 and 28, 29 and 30, and 31 and 32.

Dependent claims 33 and 34 recite that the file is in excess of 1 Gigabyte. This quantifies the feature of Applicant's method of transferring a large file exceeding a pre-selected file size limit for transmission past the firewall.

As regards the dependent claims not discussed, these claims together with their base claims and intervening claims, if any, should be patentable over Rutherglen and other known art.

**CONCLUSION**

For the foregoing reasons, Applicants respectfully submit that all pending claims are patentable over the art of record. To discuss any matter pertaining to the present application, the Examiner is invited to call the practitioner of record, Steven Swernofsky, at (650) 947-0700.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

Dated: November 24, 2008

/Arthur B. Moore/  
Arthur B. Moore  
Reg. No. 29,958

The Swernofsky Law Group  
P.O. Box 390013  
Mountain View, CA 94039-0013  
(650) 947-0700